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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/522,471
Filing Date: May 26, 2005
Appellant(s): BELL ET AL.

Keith J. Barkaus
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2-13-09 appealing from the Office action mailed 5-29-08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: only claims 1-3 and 14-16 are rejected under 35 USC 103 as being unpatentable over the published article "Innovations Article" in view of Bousche.

Appellant's brief presents arguments relating to objected claims 5-13. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,059,410

BOUSCHE et al

06-2006

Tough, G. and Denniel, S. "Innovations Key Reeled Pipe-In-Pipe Flowline" Oil & Gas Journal, (Aug. 31, 2001), pp. 46-51

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-3 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the "Innovations" article in view of Bousche (7,059,410).

The "Innovations" article teaches a double-walled pipeline with a seal in the annular space between the pipes. The inner pipe has a normal operating condition and is capable of transmitting gas. The annular space is also considered capable of allowing gas flow. The seal is a lip seal that is capable of engaging the walls of the pipes (the lip is considered a blocking means). The article teaches that the seal is not energized until required, such as when liquid is present in the annular space. However, the article does not appear to state the seal allows gas to pass through the annular space during normal operation until it is activated by liquid. Bousche teaches a lip seal in an annular spaced between to concentric elements. Bousche teaches an improved method of installation wherein the lip is bound until the seal needs to be used. The assembly has a liquid-sensitive material 25 that holds the blocking means in a non-sealing position until activated. The lip/blocking means is then moveable under the pressure of the liquid into sealing engagement. This assembly allows installation without damage to the lips and

then activation when desired. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the seal in the article with the teachings of Bousche to ensure an effective, undamaged seal when needed.

(10) Response to Argument

Claims 1-3 and 14-16

Appellant argues that the "Innovations" Article does not disclose seals that allow gas to pass through the annular space. However, the "Innovations" Article has not been applied as a 102 rejection. The claims are rejected under 103 as being obvious over the "Innovations" Article in view of Bousche. And, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, the "Innovations" Article discloses a majority of the claimed structure such as the double-walled pipe and a lip seal in the annular space between the inner and outer pipe, etc. On page 50 (around the second to last paragraph on the page), the article discloses that the lip seal is not energized until required, which is only when the annular space becomes flooded. However, the article does not appear to state the lip seal allows gas to pass through the assembly prior to it being activated by liquid. Bousche teaches a seal assembly including a lip seal that is provided in the annular space between two concentric elements. The lip seal is bound by a material that is dissolvable. Binding the seal allows the seal to be installed without damage to the lip. The tape is dissolved by liquid and thus the seal is activated in the presence of liquid.

The combination of the Article and the teachings of Bousche result in a seal that would be bound (i.e. out of contact with one of the walls) until liquid dissolves the tape and thus activates the seal. The seal would allow gas to pass under normal operating conditions until activated.

Appellant argues that Bousche does not teach that the seal is out of contact during normal operating conditions. This is unpersuasive. Again, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Bousche is being applied for its teaching of binding a seal with dissolvable tape to make installation easier and prevent damage. This also allows activation when needed. The “Innovations” Article discloses a normal operating condition and discloses the seal is not needed until liquid enters the annular chamber. Thus, the combination of the Article and Bousche's teachings result in an assembly having a seal that allows gas to pass under normal operating conditions until the chamber becomes flooded as required by the claims.

Appellant argues that Bousche does not disclose a double walled pipe. This is unpersuasive. The Article already discloses a double walled pipe as required by the claims. Bousche teaches a seal in an annular space between concentric elements and is also related to wells/pipelines. Both the Article and Bousche have lip seals in the annular space between concentric elements. Thus Bousche's teachings are relevant and beneficial to the assembly disclosed in the “Innovations” Article.

In conclusion, the combination of the “Innovations” Article in view of Bousche discloses a seal in a double walled pipe having a non-sealing position allowing gas to pass under normal operating conditions and a sealing position activated by the entry of liquid in the annular space as required by claim 1.

Claims 5-13

Appellant argues the objection to claims 5-13 should be withdrawn. Claims 5-13 were objected to as having allowable subject matter but depending from rejected claims. However, this is not believed to be an appealable issue.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Alison K. Pickard/

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